

Serial No.: 10/630,490

Attorney Docket No. 10010565-2

REMARKS

Applicant requests reconsideration of the present application in view of the foregoing amendments and the discussion that follows. The status of the claims is as follows. Claims 1-46 are pending. Claims 2, 5, 9, 26 and 31 have been amended herein and claims 48 and 49 have been added. Claims 11-25 have been withdrawn and withdrawn claims 10 and 20 were also amended. Claims 37-47 were canceled herein. Applicant reserves the right to file one or more divisional applications to the separately patentable subject matter thereof.

It should be noted that the Office Action Summary refers only to claims 1-9 and 26-36 as pending. However, as indicated above, the claims pending prior to this amendment were claims 1-46.

The Amendment

Claim 2 was amended to recite that the touch system comprises at least two opposing touch probes wherein one of the touch probes is affixed to a support member of the apparatus to which the substrate mount is affixed and the other of the touch probes is affixed to a frame member of the apparatus to which the dispensing device is affixed. Support therefor is in the specification, for example, page 13, lines 26-32.

Claims 5 and 9 were amended to correct a typographical error.

Claim 26 was amended in a manner similar to that for claim 2.

Claim 31 was amended to satisfy its dependency on claim 26.

Withdrawn claims 10 and 20 were amended to make them dependent from claim 1.

Claims 48 and 49 were added and find support in the specification, for example, page 13, lines 26-32.

Rejection under 35 U.S.C. §112

Claim 2 was rejected under the second paragraph of the above code section as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Applicant submits that the above amendment to claim 2 obviates this ground of rejection.

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Restriction Requirement

Applicant acknowledges the indication in the Office Action that claim 9 was included in Group I.

Furthermore, the restriction requirement noted that restriction was required between subcombinations usable together and that, where applicant elects a subcombination and claims thereto are subsequently found allowable, any claims depending from or other wise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with the provisions of M.P.E.P. §821.04. Withdrawn claims 10-25 have been maintained herein and claims 10 and 20 have been amended so that they respectively depend from claim 1.

Rejection under 35 U.S.C. §102

Claims 1-9 and 26-36 were rejected under paragraph (b) of the above code section as being anticipated by Cathcart, et al. (U.S. Patent No. 5,443,791) (Cathcart).

In order to maintain a rejection under 35 U.S.C. §102(b) an examiner must first establish a *prima facie* case of anticipation. An invention is anticipated if each and every limitation of the claimed Invention is disclosed in a single prior art reference. *In re Paulsen*, 30 F.3d 1475, 1478, 31 U.S.P.Q.2d 1671, 1673 (Fed. Cir. 1994). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, as stated by the Federal Circuit, anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention arranged in the claim. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 U.S.P.Q. 481 (Fed. Cir. 1984). In addition, the allegedly anticipating reference must be enabling and describe the claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the art. *In re Paulsen*, *supra*, at 1673. The anticipation determination is viewed from one of ordinary skill in the art. There must be no difference between the claimed invention and the reference disclosure as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 18 U.S.P.Q.2d 1001 (Fed. Cir. 1991).

Applicant submits that Cathcart fails to disclose or suggest at least the element of claim 1 wherein one of the substrate mount and the dispensing device is

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adapted for translation along a y-axis and for rotation about a central axis of the substrate mount that is parallel to a z-axis.

It is clear from the figures and disclosure of Cathcart that neither work surface 22 nor pipette needle 33 are adapted for rotation about a central axis parallel to a z-axis. Column 12, lines 46-58, to which the Office Action refers, does not provide any disclosure as to this element of claim 1. Furthermore, as can be seen from Figs. 1 and 3B in particular, the pipette needle housing is rectangular and fitted within a rectangular opening of transport apparatus 31. As such, it is not rotatable as required in the claim.

"All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Claim 1 includes the language that one of the substrate mount and the dispensing device is adapted for translation along a y-axis and for rotation about a central axis of the substrate mount that is parallel to a z-axis. Such a limitation is not merely a functional limitation. The structure of this element of Applicant's claim is such that the element is adapted for (as defined in the specification) rotation as claimed.

It should also be pointed out that the Office Action did not specifically identify in Cathcart elements of the apparatus of the reference that allegedly correspond to elements of Applicant's apparatus of claim 1. The Office Action refers generally to what is alleged to be disclosed in the reference. For example, the Office Action contends that Cathcart discloses an apparatus comprising a substrate mount; however, the specific element of the reference apparatus that allegedly corresponds to a substrate mount is not set forth. The only specific element identified by number in the Office action is gauge block 24, which the Office Action refers to as a calibration system. However, the relationship of gauge block 24 to the present claim language is not identified.

Claim 2 is not disclosed or suggested by Cathcart. Claim 2 is directed to an apparatus as claimed in claim 1 further comprising a touch system wherein the touch system comprises at least two opposing touch probes wherein one of the touch probes is affixed to a support member of the apparatus to which the substrate mount is affixed and the other of the touch probes is affixed to a frame member of the apparatus to which the dispensing device is affixed. Gauge block 24 does not satisfy this element of the apparatus of claim 2.

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Claim 3 is directed to an apparatus according to claim 1 wherein the optical system for positioning the substrate mount comprises at least one image sensor and the substrate comprises at least one target image for imaging by the image sensor. The optical sensors found in the apparatus of Cathcart do not include an image sensor and a target image. Therefore, claim 3 is separately patentable over the disclosure of Cathcart.

Claim 4 depends from claim 1, which is patentable over Cathcart as demonstrated above. Claim 4 is patentable over Cathcart at least by virtue of such dependency.

Claim 5 is directed to the apparatus of claim 4 wherein the calibration system comprises a locator device having a predetermined fixed target location and a camera acting in cooperation with the optical system. Cathcart does not disclose or suggest such a calibration system.

Claims 6 and 7 depend ultimately from claim 2, which is patentable over Cathcart as demonstrated above. Claims 6 and 7 are patentable over Cathcart at least by virtue of such dependency.

Claim 8 is directed to an apparatus according to Claim 1 further comprising a delivery device for delivering the substrate to the substrate mount. The delivery device has associated with it a delivery device optical system for positioning the substrate to be within the field of view of the support mount optical system. There is no disclosure or suggestion in Cathcart of such a delivery device with an associated optical system as claimed.

Likewise, claim 9 is patentable over Cathcart. The reference does not disclose or suggest a delivery device optical system that comprises at least one image sensor and the substrate comprises at least one target image for imaging by the image sensor.

Claim 26 is patentable over the teaching of Cathcart for reasons similar to those discussed above with regard to the rejection of claim 2 over Cathcart.

Claim 27 is directed to a method according to Claim 26 wherein the optical system for positioning the substrate mount comprises two or more image sensors and the substrate comprises a corresponding number of target images. Cathcart does not disclose or suggest these features of claim 27.

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Claim 28 depends from claim 26, which is patentable over Cathcart as demonstrated above. Claim 28 is, therefore, patentable over Cathcart at least by virtue of such dependency.

Claim 29 is directed to the method of claim 28 wherein the calibration system comprises a locator device having a predetermined fixed target location and a camera acting in cooperation with the optical system. Cathcart does not disclose or suggest such a calibration system.

Claims 30-36 depend ultimately from claim 26, which is patentable over Cathcart as demonstrated above. Claims 30-36 are patentable over Cathcart at least by virtue of such dependency.

New claims 48 and 49, which depend from claims 2 and 26, respectively, are patentable over the disclosure of Cathcart. The reference does not teach an apparatus having two touch probes wherein one of said touch probes is an upwardly pointing probe and the other of said touch probes is a downwardly pointing probe.

Conclusion

Claims 1-9, 26-35 and 48-49 satisfy the requirements of 35 U.S.C. §§112 and 102. Withdrawn claims 10-25 have been amended to depend from claim 1. Allowance of the above-identified patent application, it is submitted, is in order.

Respectfully submitted,



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